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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO.                    |
|--|-------------|----------------------|---------------------|-------------------------------------|
| 09/448,804   | 11/24/1999  | DAVID L. SALGADO     | D/99253-690         | 5473                                |
| 7590   | 04/07/2005  |                      |                     | EXAMINER<br>PANNALA, SATHYANARAYA R |
| CLARENCE A GREEN<br>PERMAN & GREEN LLP<br>425 POST ROAD<br>FAIRFIELD, CT 06430 |             |                      | ART UNIT<br>2167    | PAPER NUMBER                        |

DATE MAILED: 04/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |
|------------------------------|------------------------|---------------------|
|                              | 09/448,804             | SALGADO ET AL.      |
| Examiner                     | Art Unit               |                     |
| Sathyanarayan Pannala        | 2167                   |                     |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 25 February 2005.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1-17 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5)  Claim(s) \_\_\_\_\_ is/are allowed.  
6)  Claim(s) 1-17 is/are rejected.  
7)  Claim(s) \_\_\_\_\_ is/are objected to.  
8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_.

**DETAILED ACTION**

1. Applicant's Amendment filed on 1/11/2005 has been entered with claim 1 as amended and claims 15-17 as added. Claims 1-17 are pending in this Office Action.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1, 11 and 15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claim 1, first limitation used a copyright years and it does not specify the copyright years pertaining an object. As well as the second limitation states as common data, which is not specified in the specification and common data of specific object must be defined in the claim further the claim must be supported by the specification. Dependent claim 2 is also rejected under the same rationale as its independent claim 1.

In claim 11, stated as non-common data, which is not specified in the specification and non-common data of specific object must be defined in the claim further the claim must be supported by the specification.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

5. Claims 1 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Applicant's Amendment filed on 1/11/2005 in response to the Board of Patent Appeals and Interferences decision. In that paper, Applicant stated as "In Applicant's invention, common data (i.e. copyright years), is gathered from each platform, recognized as common data by the system manager, and processed by the system manager into a single list of copyright years for the system in its entirety." See page 7, first paragraph of the Amendment and this statement indicates that the invention is different from what is defined in the claim(s) because the claim 1, first limitation used a copyright years and it does not specify the copyright years pertaining an object. As well as the second limitation states as common data, which is not specified in the specification and common data of specific object must be defined in the claim further the claim must be supported by the specification. Dependent claim 2 is also rejected under the same rationale as its independent claim 1.

In claim 11, stated as non-common data, which is not specified in the specification and non-common data of specific object must be defined in the claim further the claim must be supported by the specification.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 3-6, 8-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Nakagawa et al. (USPA Pub. 2003/0159065 A1) hereinafter Nakagawa.

8. As per independent claim 3, Nakagawa teaches an apparatus for inspecting the copyright of digital data on a network having a data providing device for providing digital data on the network, and a copyright inspection device for taking out copy right information from digital data provided by data device and inspecting the copyright of the digital data based on the taken out copyright information page 1, paragraph [0010]. Nakagawa teaches the claimed step of "polling at least two platforms for attribute data"

as registered URLs (multiple URLs are equal to multiple platforms) for which copyright inspection has been completed (page 4, paragraph [0050]). Nakagawa teaches the claimed step of “collecting the attribute data from the at least two platforms in response to the step of polling” as the attributes of the digital data are recorded at least a file size for URLs (page 4, paragraph [0050], paragraph [0062]). Further, Nakagawa teaches the claimed step of “displaying the collected attribute data on a user display” as the browser 22 provides an operating environment for a user carrying out the operation of the HTML document (Fig. 3, page 4, paragraph [0050]).

9. As per dependent claim 4, Nakagawa teaches the claimed step of “collecting the attribute data from the at least two platforms in response to the step of polling” as the attributes of the digital data are recorded at least a file size for URLs (page 4, paragraph [0050], paragraph [0062]).

10. As per dependent claim 5, Nakagawa teaches the claimed step of “step of polling at least two platforms for attribute data further comprises the step of polling at least one of the at least two platforms when polling is initiated by a user request” as the copyright of digital data provided by the data providing device is inspected and the information is taken from the device (Page 1, paragraph [0011] and paragraph [0049]).

11. As per dependent claim 6, Nakagawa teaches the claimed step of “the step of collecting the attribute data from the at least two platforms in response to the step of polling further comprises the step of collecting the copyright information from the at least two platforms” as the attributes of the digital data are recorded at least a file size for URLs (page 4, paragraph [0050], paragraph [0062]).

12. As per dependent claim 8, Nakagawa teaches the claimed step of “the step of collecting the attribute data from the at least two platforms in response to the step of polling further comprises the step of storing the attribute data in non-volatile memory” as in the database 12 is stored documents described by HTML (page 1, paragraph [0047], [0050] and [0062]).

13. As per dependent claim 9, Nakagawa teaches the claimed step of “the step of displaying the collected attribute data on a user display further comprises the step of automatically displaying the attribute data collected from the at least two platforms” as carries out automatic copyright inspection with respect to plurality of HTML documents (page 4, paragraph [0050]).

14. As per dependent claim 10, Nakagawa teaches the claimed step of “the step of displaying the collected attribute data on a user display further comprises the step of manually displaying the attribute data collected from the at least two platforms” (page 1, paragraph [0007] and paragraph [0049]).

15. As per dependent claim 11, Nakagawa teaches the claimed step of “the step of displaying the collected attribute data on a user display further comprises the step of displaying only non-common attribute data collected from the at least two platforms” as the step 12, reads from the attribute recording file 26, the last update (page 5, paragraph [0063]).

***Claim Rejections - 35 USC § 103***

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

17. Claims 1-2, 7, 12-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakagawa et al. (USPA Pub. 2003/0159065) hereinafter Nakagawa, and in view of ("Strategy for Collecting Software Inventory Information Across a Local Area Network", IBM Technical Disclosure Bulletin, 12/1994) herein after IBM Disclosure.

18. As per independent claim 1, Nakagawa teaches an apparatus for inspecting the copyright of digital data on a network having a data providing device for providing digital data on the network, and a copyright inspection device for taking out copy right information from digital data provided by data device and inspecting the copyright of the

digital data based on the taken out copyright information page 1, paragraph [0010]. IBM Disclosure teaches the claimed step of "a system manager, the system being manager being adapted" as Network administrator keep track of the software on all managed systems across a LAN (page 1, paragraph 1). Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention, to have combined the teachings of the cited references because IBM Disclosure's teachings would have allowed Nakagawa's method to supervise the activities of system by System Administrator will be able to balance the workload across the managed systems in a LAN and be able to detect when problems occur (page 1, paragraph 1). Nakagawa teaches the claimed step of "collecting attribute data multiple platforms comprising copyright years from multiple platforms" as the attributes of the digital data are recorded at least a file size for URLs (page 4, paragraph [0050], paragraph [0062]). Further, Nakagawa teaches the claimed step of "recognize the attribute data as common data" as the step 12, reads from the attribute recording file 26, the last update (page 5, paragraph [0063]). Further, Nakagawa teaches the claimed step of "process the common data into a list of copyright data for the system" as taking out the information may involve selecting a method for taking out copy right information form the extension etc. of the filename of the digital data being the object of inspection (page 5, paragraph [0068]). Further, Nakagawa teaches the claimed step of "a user interface connected to the system manager for displaying the collected attribute data in the list to a user" as inspection of copyright may be executed once a week, at 12 o'clock each Saturday,

then the load on the user carrying out inspection of copyright can be reduced and also the inspection of copyright can be effectively carried out (page 6, paragraph [0088]).

19. As per dependent claim 2, IBM disclosure teaches the claimed step of “a user interface connected to the system manager for displaying attribute data in the list to a user” as for each type of software object, the agent can find all the instances that reside on the system and collect attributes, such as date and time the file was modified and the file size (page 2). Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention, to have combined the teachings of the cited references because IBM Disclosure’s teachings would have allowed Nakagawa’s method to supervise the activities of system by System Administrator will be able to balance the workload across the managed systems in a LAN and be able to detect when problems occur (page 1, paragraph 1).

20. A method as in claim 7, Nakagawa does not explicitly teach license information. However, IBM Disclosure teaches the claimed step of “the step of collecting the attribute data from the at least two platforms in response to the step of polling further comprises the step of collecting the license information from the at least two platforms” as software is being rigorously controlled, either for license control (page 1). Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention, to have combined the teachings of the cited references because IBM Disclosure’s teachings would have allowed Nakagawa’s method to supervise the activities of system by System Administrator will be able to balance the workload across the managed systems in a LAN and be able to detect when problems occur (page 1, paragraph 1).

21. As per independent claim 12, Nakagawa teaches an apparatus for inspecting the copyright of digital data on a network having a data providing device for providing digital data on the network, and a copyright inspection device for taking out copy right information from digital data provided by data device and inspecting the copyright of the digital data based on the taken out copyright information page 1, paragraph [0010]. ("Strategy for Collecting Software Inventory Information Across a Local Area Network", IBM Technical Disclosure Bulletin, 12/1994) herein after IBM Disclosure. IBM Disclosure teaches the claimed step of "a system manager, the system being manager being adapted" as Network administrator keep track of the software on all managed systems across a LAN (page 1, paragraph 1). Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention, to have combined the teachings of the cited references because IBM Disclosure's teachings would have allowed Nakagawa's method to supervise the activities of system by System Administrator will be able to balance the workload across the managed systems in a LAN and be able to detect when problems occur (page 1, paragraph 1). Nakagawa teaches the claimed "a system controller for collecting the software copyright data from multiple platforms" as the attributes of the digital data are recorded at least a file size for URLs (page 4, paragraph [0050], paragraph [0062]). Further, Nakagawa teaches the claimed "a user interface connected to the system controller for displaying the software copyright data from the memory to a user" as inspection of copyright may be executed once a week, at 12 o'clock each Saturday, then the load on the user carrying out inspection of copyright

can be reduced and also the inspection of copyright can be effectively carried out (page 6, paragraph [0088]).

22. As per dependent claim 13, Nakagawa teaches the claimed “the system controller for collecting the software copyright data from multiple platforms further comprises a memory for storing the software copyright data collected by the system controller” as attribute recording file (page 5, paragraph [0063]).

23. As per dependent claim 14, Nakagawa teaches the claimed “the memory for storing the software copyright data collected by the system controller further comprises non-volatile memory” as magnetic disk, magnetic drum, etc (page 6, paragraph [0089]).

24. As per dependent claim 15, Nakagawa teaches the claimed “the system manager collects attribute data from multiple platforms simultaneously” (page 6, paragraph [0088]).

25. As per dependent claim 16, Nakagawa teaches the claimed “the attribute data collected is attribute data stored on the multiple platforms and is passed to the user interface” (page 4, paragraph [0050]).

26. As per dependent claim 17, Nakagawa teaches the claimed “the list is a list of copyright years for the system in its entirety” as the attributes of the digital data the last update date (page 4, paragraph [0050]).

***Response to Arguments***

27. Applicant's arguments with respect to claims 1-17 have been considered but are moot in view of the new ground(s) of rejection. The two new references teach all the claims and its limitations.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sathyanarayan Pannala whose telephone number is (571) 272-4115. The examiner can normally be reached on 8:00 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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*SP*  
Sathyana<sup>r</sup>ayan Pannala  
Examiner  
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srp  
March 29, 2005

*Debra S. Wassum*  
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